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SEP 20 2006

Appl. No. 10/678,023  
Amdt. dated September 20, 2006  
Reply to Office Action of May 30, 2006

PATENT

### REMARKS/ARGUMENTS

#### Status of the Claims

Claims 1-11 are pending in this application. Claims 4, 5 and 7-11 are withdrawn from consideration. Claims 1-3 and 6 are rejected.

Claims 1-3, 6, are rejected under 35 U.S.C. §112 First Paragraph as containing subject matter not described in such a way as to convey that the inventors had possession of the invention at the time the application was filed.

Claims 1-3 and 6 are further rejected under 35 U.S.C. §102(b)/103(a) as being anticipated by or in the alternative made obvious by Martin et al (2002).

Claims 1-3, and 6 are rejected under 35 U.S.C. §112, Second Paragraph for failing to point out and distinctly claim the subject matter the Applicants regard as their invention.

#### The Amendments

Support for the amendments is as follows.

Support for the amendment to claim 1 is found in original claim 2 wherein it is stated that: the identifying characteristics of the strain are that of NRRL B-30655. Support for the amendment to claim 3 is found on pages 20-24 of the specification, wherein the isolation of the *Chromobacterium* and SEQ ID NO. of said isolate is set forth. No new matter is added.

#### The Rejections

##### Rejections under 37 U.S.C. §112

##### 1st Paragraph

The Examiner rejects claims 1-3 and 6 under 35 U.S.C. §112(1) as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or which it is most nearly connected, to make and/or use the invention. The basis of this rejection was whether applicant had set forth explicit statements that the purpose of the biological deposit was for the purpose of patent procedure and that restrictions on

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the availability to the material to the public will be irrevocably removed upon the granting of the patent.

Applicant submits that the current amendments to the specification regarding the deposit language remedy this rejection.

## 2nd Paragraph

The Examiner rejects claims 1-3 and 6 under 35 U.S.C. §112(2) as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 lacking a period has been amended to correct the deficiency.

Claim 2 has been amended to recite "all of the identifying characteristics" instead of "the identifying characteristics". The Applicants thank the Examiner for her suggestion as to how the claim could be amended.

Claim 3 was cited as being rejected under 112(2), however, there was no basis for the rejection of the claim under 112(2) set forth in the office action mailed on 5/30/06.

Claim 6 was rejected as "indefinite and confusing in that it is unclear that the strain of claim 1 in any amount would be useful for control of any and all insect pests." Applicant respectfully disagrees with the rejection of claim 6 under 112(2). The test for definiteness under 35 U.S.C. 112, second paragraph, is "whether those skilled in the art would understand what is claimed when the claim is read in light of the specification.....If one of skill in the art is able to ascertain the meaning of the terms....35 U.S.C. 112, second paragraph, is satisfied." (MPEP, 2173.02).

Although applicant asserts that one of skill in the art would know from the claim language what the scope of the specified strain is, as well as what "insect pests" are, the specification provides further support for one of skill in the art to objectively ascertain what are the metes and bounds of the claimed terms. Pages 11 – 20 of the specification detail the bacterium providing the insecticidal activity, what constitutes insecticidal activity, as well as representative insect pests. Assuming *arguendo* that the examiner's arguments are based on whether the claim term recites an amount effective to provide insecticidal activity, the phrase "effective amount" has been held to be indefinite when the claim fails to state the function which

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is to be achieved and more than one effect can be implied from the specification or the relevant art." (MPEP 2173.05 (c) (III)). In the case of the instant claim, the function to be achieved is clearly set forth in the claim language, control of insect pests; moreover, the specification does not imply that some other effect can be achieved outside the scope of insecticidal activity.

**Rejections under 35 U.S.C. §102(b)**

Applicant would like to thank the examiner for the interview on August 16, 2006, to clarify the rejections of record and identify claim language which would overcome the 102(b)/103(a) rejection of record.

The Examiner rejects claims 1-3 and 6 under 35 U.S.C. §102(b)/103(a) as being anticipated by or in the alternative made obvious by Martin et al (2002).

Claim 1 has now been amended to include the strain characteristics as having all of the identifying characteristics of NRRL B-30655. This limitation is not present in the cited reference and so the amendment should place the claims in a position for allowance.

Claim 2 has been canceled.

Claim 3 has now been amended to include the gene sequence of SEQ ID NO:1. This limitation is not present in the cited reference and so the amendment should place the claims in a position for allowance.

Claim 6 is dependent upon claim 1, in light of the foregoing amendment to claim 1, the claim should be in position for allowance.

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CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested. If a telephone conference would expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (510) 559-5731.

Respectfully submitted,



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